

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of: Venegas, Jr.

Application No.: 09/771,227

Confirmation No.: 6935

Filed: January 26, 2001

Art Unit: 3635

For: CART CORRAL

Examiner: M. R. Wendell

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being submitted in response to arguments raised in the Examiner's Answer mailed November 25, 2009.

Overall, Appellant continues to insist that the Examiner's interpretation of the claims on appeal is not consistent with the interpretation that would be advanced by a person of ordinary skill in the art. The Examiner's reference to *KSR Int'l v Teleflex Inc.* seems to disregard the *Graham* factual inquiries which, in fact, were reinforced through the KSR decision.

Under *Graham*, in determining the scope and content of the prior art, the Examiner must first obtain a thorough understanding of the invention disclosed and claimed in the application under examination by reading the specification, including the claims, to understand what the applicant has invented. See MPEP § 904. The scope of the claimed invention must be clearly determined by giving the claims the "*broadest reasonable interpretation consistent with the specification.*" See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005, emphasis added) and MPEP §2111. Once the scope of the claimed invention is determined, the Examiner may then determine what to search for and where to search.

In this case, the Examiner has failed to accurately determine the scope of Appellant's claims because the Examiner's interpretation is unreasonable. In particular:

**a coat of paint cannot reasonably be interpreted
as a removable and replaceable polymerized sheathing.**

Appellant admits:

- 1) a coat of paint can be removed; for example, by scraping or through the use of paint remover;
- 2) something that was painted before can be stripped and painted again; and
- 3) some paints presumably contain polymers.

But these observations do not mean that a coat of paint represents a removable and replaceable polymerized sheathing.

The same holds true of the Examiner's argument that a coat of paint applied to a piece of tubing has a diameter.

Again, Appellant admits that if a laboratory cuts a painted cylindrical railing in half, a microscope could be used to determine the thickness of the paint layer, and from this, one could concoct an "inner diameter" and an "outer diameter," but this does not make sense. Not only is this interpretation unreasonable, the paint certainly could not have an "inner diameter" greater than *or equal to* the diameter of the rail, and this would require the paint to be somehow spaced-apart for the surface that was painted.

Appellant could continue with similar rebuttals to the Examiner's arguments but will instead rest upon arguments of record. In closing, however, it is noted that the Examiner states that "[t]he Applicant has not supplied enough information as to why they do not think it is obvious to combine the references." Not only has Appellant provided sufficient argument, Appellant would like to remind that it is the Examiner's mandate to establish *prima facie* obviousness—it is not Appellant's job to prove nonobviousness in advance.

Respectfully submitted,

By: _____

Date: January 22, 2010

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